

## REMARKS

The kindness and helpfulness of Examiner Vaughn and Examiner Shin during the interview of January 24, 2005 are acknowledged and were greatly appreciated. Dale Lazar and Lisa Norton attended the interview. The following remarks were presented at the interview.

Claims 1-52 are pending in the application. Claims 1, 12, 16, 22, 30, 34, 38, 42, 45, and 47-49 are the independent claims.

The Office Action indicated that Claims 1, 2, 7-9, 12-19, 21-23, 30, 31 ,33-42, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge (U.S. 6,515,988). The Office Action also indicated that Claims 3-6, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge in view of Hayakawa (U.S. 6,765,559). In addition, the Office Action indicated that Claims 10 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge in view of Browning (U.S. 6,707,781). Finally, the Office Action indicated that Claims 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge in view of Hochendorner (U.S. 6,771,568). Applicants respectfully disagree.

### 35 U.S.C. 102 Rejections

The Office Action indicated that Claim 1 was rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge (U.S. 6,515,988). Applicant respectfully disagrees.

Eldridge teaches a portable device that receives, transmits, and processes tokens. (Eldridge, Field of the Invention.) Tokens are a reference to a document or to a document service. (Eldridge, column 2, lines 1-4.) Tokens “contains the small amount of essential information which allows the system ... to initiate actions which produce the desired result.” (Eldridge, column 5, line 65 – column 6, line 1.) In Eldridge, the tokens include all of the

following information: the operation that is to be performed; the address of the document or the address of the system providing the document service; a parameter defining a property of a document or a service; and a security parameter. (Eldridge, column 2, lines 18-46; see also Eldridge, column 1, lines 53-67.) Eldridge is used so that services can be performed on documents by transmitting tokens (including document identifiers) instead of the documents themselves.

In contrast, Applicant's specification teaches using a portable device to **identify a document by capturing and transmitting actual data from the document**. Eldridge does not teach capturing and transmitting actual data from the document for the purpose of identifying the document. In fact, Eldridge requires an identifier for the document before it can identify the document. Furthermore, **no discussion of capturing actual data from the document is discussed in Eldridge**. This feature of **identifying a document by capturing and transmitting actual data from the document** is supported in Applicant's specification. (See, e.g., paras. 6.) This feature is also supported in Claim 1, as indicated in bold below:

1. A method for sending information to a data processing apparatus for identification of a document having the information using a handheld device capable of communicating with the data processing apparatus, the handheld device having a memory, the method comprising:
  - providing the document;
  - capturing the information from the document, **wherein the information comprises actual data from the document**;
  - storing the captured information in the memory of the handheld device as document data;
  - establishing a communications path between the handheld device and the data processing apparatus;
  - retrieving the document data from the memory of the handheld device; and
  - sending the retrieved document data from the handheld device to the data processing apparatus through the communications path **for identification of the document**.

Amended independent claims 12, 16, 22, 30, 34, 38, 42, 45, and 47-49 include this same feature. Applicant respectfully submits that Claims 1, 12, 16, 22, 30, 34, 38, and 42 are thus

patentable over Eldridge. Claims 2-11, 13-15, 17-21, 23-29, 31-33, 35-37, 39-41, 43-44, and 50-53 depend on the amended independent claims, and are also thus allowable.

### 35 U.S.C. 103 Rejections

The Office Action rejected Claims 3-6, and 24-27 under 35 U.S.C. 103(a) as being unpatentable over Eldridge in view of Hayakawa (U.S. 6,765,559). Claims 3-6 depend, directly or indirectly, on independent Claim 1, and Claims 24-27 depend, directly or indirectly, on independent Claim 22. As explained above, independent Claims 1 and 22 are allowable because they include the feature of identifying a document by capturing and transmitting actual data from the document, which is not taught in Eldridge. Furthermore, Hayakawa does not teach the feature of identifying a document by capturing and transmitting actual data from the document. Thus, Claims 3-6 and Claims 24-27 are also allowable.

The Office Action rejected Claims 10 and 28 under 35 U.S.C. 103(a) as being unpatentable over Eldridge in view of Browning (U.S. 6,707,781). Claims 10 depends on independent Claim 1, and Claim 28 depends on independent Claim 22. As explained above, independent Claims 1 and 22 are allowable because they include the feature of identifying a document by capturing and transmitting actual data from the document, which is not taught in Eldridge. Furthermore, Browning does not teach the feature of identifying a document by capturing and transmitting actual data from the document. Thus, Claims 10 and 28 are also allowable.

The Office Action rejected Claims 11 and 29 under 35 U.S.C. 103(a) as being unpatentable over Eldridge in view of Hochendorner (U.S. 6,771,568). Claim 11 depends on independent Claim 1, and Claim 29 depends on independent Claim 22. As explained above,

independent Claims 1 and 22 are allowable because they include the feature of identifying a document by capturing and transmitting actual data from the document, which is not taught in Eldridge. Furthermore, Hochendoner does not teach the feature of identifying a document by capturing and transmitting actual data from the document. Thus, Claims 11 and 29 are also allowable.

Concluding Remarks

Applicants believe the objections and rejections in the Office Action have been addressed and that the application is now in condition for allowance. The Examiner is invited to contact the undersigned by telephone should the Examiner believe that personal communication will expedite prosecution of this application.

Respectfully submitted,

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